

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket 0275D-000247

Group Art Unit: 2834

Examiner: Karl Tamai

Serial No. 09/293,455

Filing Date: April 16, 1999

Applicant: Stephen A. Debelius

For: **ARMATURE SHAFT RETAINER**



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AMENDMENT

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on January 9, 2001.

By W. R. O. S.

Dear Sir:

In response to the Office Action dated October 24, 2000, please consider the following:

REMARKS

Claims 1 through 21 remain pending in the present application. No claims have been amended.

REJECTION UNDER 35 U.S.C. §103

The Examiner has rejected the claims under 35 U.S.C. §103(a). The Examiner rejects Claims 1 through 4, 7 through 11, 14 through 18 and 21 as being unpatentable over Dafler in view of Wrobel. Also, the Examiner has rejected Claims 6, 13 and 20 as being unpatentable over the above references further in view of Rosenthal, Jr. et al.

Independent Claim 1, among other elements, includes at least one bearing on the shaft with the bearing having a central bore with an enlarged portion opening towards one end of the shaft. Also, a retainer is on the shaft positioned within the enlarged bore portion of the bearing.

The Examiner alleges that Dafler teaches every aspect of the invention except for the bearing having an enlarged portion for receiving the retainer and the bearing having a stepped configuration to receive the bearing. The Dafler reference cited by the Examiner illustrates a retainer 84 on the end of the shaft. Adjacent the retainer 84 is the bearing 28. The Dafler reference continues to illustrate a mechanism for retaining the bearing in the housing.

The Wrobel reference cited by the Examiner illustrates a bearing for small size fans and, in one embodiment, illustrates a bearing which is retained on a shaft by a slip ring in an opening on the bearing. The Examiner alleges that this combination would render Applicant's invention obvious to those skilled in the art.

The court, in In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992), states that:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." at 1783 emphasis original.

Here, there is no suggestion or motivation of the desirability to combine the Wrobel reference with the Dafler reference. In fact, both teach different types of retainers. Further, the bearings are different and there is no suggestion or motivation to substitute one bearing for the other.

The Examiner is relying upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that:

"[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Fritch, supra, 1784.

This is exactly what the Examiner has done in applying the Section 103 rejection. The Examiner has pieced together the two references to allegedly render Applicant's invention obvious. It is clear that the Examiner cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Accordingly, Applicant believes Claim 1 to be patentably distinguishable over the art cited by the Examiner. Likewise, Claims 2 through 7 which depend from Claim 1 are patentably distinct over the references.

Independent Claims 8 and 15 are patterned after Claim 1. The above remarks with respect to Claim 1 equally apply to Claims 8 and 15. Accordingly, Applicant believes these claims, as well as their dependent claims, to be patentably distinct over the art cited by the Examiner.

CONCLUSION

In light of the above remarks, Applicant would submit that all pending claims are in condition for allowance. Accordingly, Applicant respectfully requests the Examiner to pass the case to issue at his earliest possible convenience.

Should the Examiner have any questions regarding the present application, he should not hesitate to contact the undersigned at (248) 641-1600.


Respectfully submitted,

HARNESS, DICKY & PIERCE, P.L.C.

Dated: January 9, 2001

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